

Supreme Court, U. S.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1975

No. 75-1743

FRANK PETER DOYLE, JOHN HERBERT CHARLES NAYLER
and GEORGE NEWBOLD ROLINSON,

Petitioners,

—v.—

JOHN C. SHEEHAN,

Respondent.

**PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS
FOR THE FIRST CIRCUIT**

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TABLE OF CONTENTS

	PAGE
Opinions Below	1
Jurisdiction	2
Questions Presented	2
Statutes Involved	4
Statement of the Case	6
 REASONS FOR GRANTING THE WRIT	
1. The Decision of the First Circuit Directly Conflicts With Decisions of the Second, Fifth, Sixth, Seventh and Tenth Circuits and Numerous District Courts Which Have Uniformly Recognized That Parties to a Patent Office Interference May Obtain Discovery in a Federal Court Proceeding Pursuant to 35 U.S.C. §24	8
2. The First Circuit's Interpretation of 35 U.S.C. §24 Which Restricts the Phrase "Federal Rules of Civil Procedure" to Mean Federal Rule of Civil Procedure 45 Except for Subpart (d)(1) Is in Direct Conflict With This Court's "Plain Meaning" Rule of Statutory Interpretation	10
3. The Effect of the First Circuit's Decision Will Be to Suppress Relevant and Material Evidence so That When an Interference Reaches the Patent and Trade Mark Office's Board of Patent Interferences for Decision, the Case Will Be Decided on a Record Which Contains Less Than All of the Relevant and Material Evidence	14

	PAGE
CONCLUSION	15
APPENDIX A—	
Opinion of the Court of Appeals for the First Circuit	1a
APPENDIX B—	
Opinion of the District Court for Massachusetts	5a
APPENDIX C—	
Dissent of Judge Van Dusen in <i>Frilette et al.</i> case	6a
APPENDIX D—	
Summary of cases recognizing right of Patent Interference party to discovery in 35 U.S.C. 24 proceeding	11a

TABLE OF AUTHORITIES

Cases:

The Babcock & Wilcox Company v. Foster Wheeler Corporation, 415 F.2d 875 (CA 3, 1969)	8, 9
The Babcock & Wilcox Company v. Foster Wheeler Corporation, 432 F.2d 385 (CA 3, 1970); cert. den'd 396 U.S. 57 (1971)	8, 9
The Babcock & Wilcox Company v. Foster Wheeler Corporation, 457 F.2d 1307 (CA 3, 1972)	9
The Babcock & Wilcox Company v. Foster Wheeler Corporation, 166 USPQ 390 (DC NJ, 1970)	9, 10
The Babcock & Wilcox Company v. Foster Wheeler Corporation, 54 FRD 474 (DC NJ, 1971)	9, 10
The Babcock & Wilcox Company v. Foster Wheeler Corporation, 173 USPQ 480 (DC NJ, 1972)	9, 10

	PAGE
The Babcock & Wilcox Company v. Foster Wheeler Corporation, 174 USPQ 147 (DC NJ, 1972)	9, 10
Banks v. Chicago Grain Trimmers Assn., Inc., et al., 390 U.S. 459 (1968)	11
Duffy v. Barnes, et al., 508 F.2d 205 (CA 3, 1974), cert. denied, 421 U.S. 979 (1975)	2, 9
Frilette, et al. v. Kimberlin, et al., 508 F.2d 205 (CA 3, 1974), cert. denied, 421 U.S. 979 (1975)	2, 9, 10, 14
Hellwarth et al. v. Gould et al., 46 FDR 620 (DC Del., 1967)	9, 10
Helvering v. Hammell, 311 U.S. 540 (1941)	13
International Business Machines Corporation v. Sperry Rand Corporation, 155 USPQ 633 (DC Del., 1967) ..	9, 10
In re Natta, 388 F.2d 215 (CA 3, 1968)	8, 9
Natta et al. v. E. I. du Pont de Nemours & Co., 410 F.2d 187 (CA 3, 1969); cert. den'd 163 USPQ 704	8, 9
In re Natta et al., 151 USPQ 93 (DC Del., 1966)	9, 10
In re Natta, 264 F. Supp. 731 (DC Del., 1967)	9, 10
In re Natta et al., 162 USPQ 338 (DC Del., 1969)	9, 10
In re Natta, 48 FRD 319 (DC Del., 1969)	9, 10
In re Natta, 164 USPQ 71 (DC Del., 1969)	9, 10
Malat v. Riddell, 383 U.S. 596 (1966)	12
Montecatini Edison S.p.A. v. E. I. du Pont de Nemours & Co., 434 F.2d 70 (CA 3, 1970)	9
Segal, et al. v. Rochell, 382 U.S. 375 (1966)	13
Shattuck, et al. v. Hoegl, et al., 523 F.2d 509 (C.A. 2, 1975)	3, 10

	PAGE
Taub et al. v. Rausser et al., 159 USPQ 220 (DC NJ, 1968)	9, 10

Vogel et al. v. Jones et al., 443 F.2d 257 (CA 3, 1971); cert. den'd 404 US 987 (1971)	9
Vogel et al. v. Jones et al., 350 F. Supp. 419 (DC NJ, 1972); aff'd 464 F.2d 574 (CA 3, 1972)	9

Statutes:

Constitution of the United States, Article I, Section 8	16
Title 35 of the United States Code	16
35 U.S.C. §24	<i>passim</i>
35 U.S.C. §54	5, 14

Authority:

Federal Rules of Civil Procedure:	
Rule 45	11, 12, 14

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**PETITION FOR A WRIT OF CERTIORARI TO THE
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Frank Peter Doyle, John Herbert Charles Nayler and George Newbold Rolinson, the above Petitioners, request that a Writ of Certiorari issue to review the judgment of the United States Court of Appeals for the First Circuit entered in this case on January 30, 1976.

Opinions Below

The Opinion of the Court of Appeals for the First Circuit is reported at 529 F.2d 38 and 188 USPQ 545. A copy is attached hereto as Appendix A. The opinion of the United States District Court for Massachusetts is not reported; a copy is attached hereto as Appendix B.

Jurisdiction

The judgment of the Court of Appeals for the First Circuit was entered on January 30, 1976. A timely Petition for Rehearing *en banc* was denied on March 3, 1976, and this Petition for a Writ of Certiorari was filed within ninety days of that date. This court's jurisdiction is invoked under 28 U.S.C. §1254(1).

Questions Presented

For over ten years the federal courts have overseen "discovery" for use in Patent Office interferences* pursuant to 35 U.S.C. §24. During the period from 1966 to 1974, the Second, Third, Fifth, Sixth, Seventh and Tenth Circuits uniformly recognized the right of parties to a Patent Office interference to obtain discovery of documents and materials and to take depositions for use in such proceedings. In 1975, the Third Circuit, in *Frilette, et al. v. Kimberlin, et al.* and a companion case of *Duffy v. Barnes, et al.*, 508 F.2d 205 (C.A. 3, 1974), cert. denied, 421 U.S. 979 and 980 (1975), overruled its eight prior opinions and the twelve decisions of the district courts within the Third Circuit and interpreted 35 U.S.C. §24 in a manner which precluded Patent Office interference parties from obtaining Federal Court discovery under §24. The First Circuit, in

its decision sought to be reviewed by this Petition, adopted much of the reasoning of the Third Circuit. In the meantime, the Second Circuit reaffirmed the right of patent interference parties to obtain discovery under 35 U.S.C. §24. See *Shattuck, et al. v. Hoegl, et al.*, 523 F.2d 509 (C.A. 2, 1975).

The First Circuit adopted much of the Third Circuit's interpretation of 35 U.S.C. §24, in its decision below, and has thus rendered a decision contrary to that of five other Circuit Courts of Appeals. The First Circuit recognized the split its decision was causing:

We regret the uncertainty which a circuit split creates. There are, however, possible remedies. The Supreme Court may think it desirable to terminate the divergent interpretations that now exist.

The questions presented are as follows:

1. Should the phrase in 35 U.S.C. §24, "The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent Office," be interpreted to mean that only Federal Rule of Civil Procedure 45, and only subparts (a), (b), (c), (d)(2), (e) and (f) [but not (d)(1)], shall apply as the First Circuit has stated?
2. Should the phrase in 35 U.S.C. §24, "The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent Office," be interpreted contrary to the "plain meaning" of the words used to restrict the applicable Federal Rules to

* An interference is a proceeding in the Patent and Trademark Office between two or more parties, each of whom claims to be the first inventor of the same subject matter. The purpose of the proceeding is to establish which party is, in fact, the first inventor, since only the true first inventor is entitled to receive a patent and the accompanying seventeen-year monopoly under the Patent Statutes.

less than all the rules relating to the attendance of witnesses and to the production of documents and things?

3. Should the Federal Courts deny discovery of documents and things in Patent Office interferences thereby suppressing the discovery of relevant and material documents and things so that the Patent Office will in turn render a decision in an interference based on less than all of the relevant evidence?

Statutes Involved

35 U.S.C. §24 reads as follows:

§24. Subpoenas, witnesses

The clerk of any United States court for the district wherein testimony is to be taken for use in any contested case in the Patent and Trademark Office, shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent and Trademark Office.

Every witness subpoenaed and in attendance shall be allowed the fees and traveling expenses allowed to witnesses attending the United States district courts.

A judge of a court whose clerk issued a subpoena may enforce obedience to the process or punish dis-

obedience as in other like cases, on proof that a witness, served with such subpoena, neglected or refused to appear or to testify. No witness shall be deemed guilty of contempt for disobeying such subpoena unless his fees and traveling expenses in going to, and returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpoena; nor for refusing to disclose any secret matter except upon appropriate order of the court which issued the subpoena.

As amended Jan. 2, 1975, Pub.L. 93-596, § 1, 88 Stat. 1949.

35 U.S.C. §54, prior to July 19, 1952, read as follows:

The clerk of any court of the United States, for any district or Territory wherein testimony is to be taken for use in any contested case pending in the Patent Office, shall, upon the application of any party thereto, or of his agent or attorney, issue a subpoena for any witness residing or being within such district or Territory, commanding him to appear and testify before any officer in such district or Territory authorized to take depositions and affidavits at any time and place in the subpoena stated. But no witness shall be required to attend at any place more than forty miles from the place where the subpoena is served upon him; and the provisions of section 647, of Title 28 relating to the issuance of subpoenas duces tecum shall apply to contested cases in the Patent Office.

Statement of the Case

Frank Peter Doyle, John Herbert Charles Nayler and George Newbold Rolinson, the Petitioners herein and John C. Sheehan, the Respondent herein, are involved in an interference in the Patent and Trademark Office, the purpose of which is to determine which of the parties was the first inventor of a basic and commercially valuable process for producing a very wide range of penicillins, including most of those currently being sold. These penicillins are antibiotics and are administered each year to millions of people by doctors throughout the United States and the rest of the world to treat bacterial infections.

From 1964 through 1970, Doyle *et al.* sought unsuccessfully to compel the Patent Office to declare an interference between their patent application and Sheehan's then-pending patent application, which, on December 1, 1964, was issued as U. S. Patent No. 3,159,617. Doyle *et al.*'s activities in pursuance of a declaration of interference began with a request in the Patent Office and included litigation in the District Court for the District of Columbia, the Court of Appeals for the District of Columbia and a Petition for Certiorari to this court. Finally, on February 18, 1971, the Patent and Trademark Office declared the requested interference. The Patent Office has suspended the interference proceeding pending resolution of Doyle *et al.*'s request for additional discovery.

Doyle *et al.* are British subjects residing in Great Britain, while Sheehan is a United States citizen residing in Massachusetts. Pursuant to 35 U.S.C. §24, Doyle *et al.* applied to the District for Massachusetts for a subpoena duces tecum for service on John C. Sheehan and pursuant

thereto have already taken a discovery deposition and had production of documents. In that earlier proceeding, the District Court for Massachusetts denied Sheehan's motion to quash the subpoena duces tecum.

As a result of the documents and materials produced and the deposition of John C. Sheehan, Doyle *et al.* discovered an apparent discrepancy between the laboratory notebooks produced by Sheehan involving the invention which he claimed was his, which notebooks showed that all the work on the invention was performed by someone else, and the inventorship entity on the Sheehan patent, which was Sheehan alone. Since Sheehan, in the Patent Office interference, was relying on a date of an earlier abandoned application filed in his name alone to establish that he was the first inventor and should be awarded the right to the patent for the invention in question, Doyle *et al.* sought further production of documents pursuant to 35 U.S.C. §24 and again obtained a subpoena duces tecum from the Massachusetts District Court for the purpose of taking further discovery on the question of this apparent inventorship discrepancy. Doyle *et al.* believe that the documents and materials requested in the subpoena duces tecum served on Sheehan will reveal a concerted plan by Sheehan pursuant to which he named himself as the sole inventor of numerous inventions despite the fact that the inventions were actually produced by various graduate and postgraduate students within his Department of Chemistry at the Massachusetts Institute of Technology. Upon being served with this second subpoena duces tecum, Sheehan again moved in the District Court to quash the subpoena, which action Doyle *et al.* opposed. After resetting the case for hearing four different times, the District Court "allowed" Sheehan's Motion to

Quash without a hearing while the case was on the hearing calendar.

Doyle et al. thereafter appealed to the First Circuit Court of Appeals, which court affirmed the quashing of the subpoena duces tecum served on Sheehan.

REASONS FOR GRANTING THE WRIT

1. The Decision of the First Circuit Directly Conflicts With Decisions of the Second, Fifth, Sixth, Seventh and Tenth Circuits and Numerous District Courts Which Have Uniformly Recognized That Parties to a Patent Office Interference May Obtain Discovery in a Federal Court Proceeding Pursuant to 35 U.S.C. §24.

The First Circuit recognized that its decision was creating a split within the circuits:

We regret the uncertainty which a circuit split creates. There are, however, possible remedies. The Supreme Court may think it desirable to terminate the divergent interpretations that now exist.

In the briefs before it, and at oral argument, *Doyle et al.* discussed in detail the ten years of case law recognizing the right of a party to a Patent Office interference to obtain discovery from his adversary in an ancillary proceeding under 35 U.S.C. §24.* (See Appendix D for a summary of

* *In re Natta*, 388 F.2d 215 (CA 3, 1968); *Natta et al. v. E. I. du Pont de Nemours & Co.*, 410 F.2d 187 (CA 3, 1969); cert. den'd 163 USPQ 704; *The Babcock & Wilcox Company v. Foster Wheeler Corporation*, 415 F.2d 875 (CA 3, 1969); *The Babcock & Wilcox Company v. Foster Wheeler Corporation*, 432 F.2d 385 (CA 3,

cases.) Moreover, until 1975, the Third Circuit, in eight separate opinions, had acknowledged the right of interference parties to discovery pursuant to the Federal Rules of Civil Procedure and 35 U.S.C. §24.* During the nine-year period from 1966 to the time of *Frilette et al. v. Kimberlin et al.* and the companion case of *Duffy v. Barnes et al.*, *supra*, there were twelve decisions of District Courts within the Third Circuit recognizing an interference party's right

1970); cert. den'd 168 USPQ 673; *Montecatini Edison S.p.A. v. E. I. du Pont de Nemours & Co.*, 434 F.2d 70 (CA 3, 1970); *Vogel et al. v. Jones et al.*, 443 F.2d 257 (CA 3, 1971); cert. den'd 404 US 987 (1971); *Vogel et al. v. Jones et al.*, 350 F. Supp. 419 (DC NJ, 1972); aff'd 464 F.2d 574 (CA 3, 1972); *The Babcock & Wilcox Company v. Foster Wheeler Corporation*, 457 F.2d 1307 (CA 3, 1972).

In re Natta et al., only at 151 USPQ 93 (DC Del., 1966); *In re Natta*, 264 F. Supp. 731 (DC Del., 1967); *International Business Machines Corporation v. Sperry Rand Corporation*, only at 155 USPQ 633 (DC Del., 1967); *Hellwarth et al. v. Gould et al.*, 46 FDR 620 (DC Del., 1967); *Taub et al. v. Rausser et al.*, only at 159 USPQ 220 (DC NJ, 1968); *In re Natta et al.*, only at 162 USPQ 338 (DC Del., 1969); *In re Natta*, 48 FRD 319 (DC Del., 1969); *In re Natta*, only at 164 USPQ 71 (DC Del., 1969); *The Babcock & Wilcox Company v. Foster Wheeler Corporation*, only at 166 USPQ 390 (DC NJ, 1970); *The Babcock & Wilcox Company v. Foster Wheeler Corporation*, 54 FRD 474 (DC NJ, 1971); *The Babcock & Wilcox Company v. Foster Wheeler Corporation*, only at 173 USPQ 480 (DC NJ, 1972); *The Babcock & Wilcox Company v. Foster Wheeler Corporation*, only at 174 USPQ 147 (DC NJ, 1972).

* *In re Natta*, 388 F.2d 215 (CA 3, 1968); *Natta et al. v. E. I. du Pont de Nemours & Co.*, 410 F.2d 187 (CA 3, 1969); cert. den'd 163 USPQ 704; *The Babcock & Wilcox Company v. Foster Wheeler Corporation*, 415 F.2d 875 (CA 3, 1969); *The Babcock & Wilcox Company v. Foster Wheeler Corporation*, 432 F.2d 385 (CA 3, 1970); cert. den'd 168 USPQ 673; *Montecatini Edison S.p.A. v. E. I. du Pont de Nemours & Co.*, 434 F.2d 70 (CA 3, 1970); *Vogel et al. v. Jones et al.*, 443 F.2d 257 (CA 3, 1971); cert. den'd 404 US 987 (1971); *Vogel et al. v. Jones et al.*, 350 F. Supp. 419 (DC NJ, 1972); aff'd 464 F.2d 574 (CA 3, 1972); *The Babcock & Wilcox Company v. Foster Wheeler Corporation*, 457 F.2d 1307 (CA 3, 1972).

to discovery under the Federal Rules of Civil Procedure pursuant to 35 U.S.C. §24.*

While the First Circuit's decision adopted the reasoning of the Third Circuit in *Frilette v. Kimberlin, supra*, subsequent to that decision of the Third Circuit, the Second Circuit reaffirmed the right of discovery in *Shattuck et al. v. Hoegl et al., supra*. Therefore, the First Circuit decision stands in direct contradiction to the position of the Courts of Appeals for the Second, Fifth, Sixth, Seventh and Tenth Circuits.

2. The First Circuit's Interpretation of 35 U.S.C. §24 Which Restricts the Phrase "Federal Rules of Civil Procedure" to Mean Federal Rule of Civil Procedure 45 Except for Subpart (d)(1) Is in Direct Conflict With This Court's "Plain Meaning" Rule of Statutory Interpretation.

35 U.S.C. §24 says:

The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent Office.

* *In re Natta et al.*, only at 151 USPQ 93 (DC Del., 1966); *In re Natta*, 264 F. Supp. 734 (DC Del., 1967); *International Business Machines Corporation v. Sperry Rand Corporation*, only at 155 USPQ 633 (DC Del., 1967); *Hellwarth et al. v. Gould et al.*, 46 FRD 620 (DC Del., 1967); *Taub et al. v. Rausser et al.*, only at 159 USPQ 220 (DC NJ, 1968); *In re Natta et al.*, only at 162 USPQ 338 (DC Del., 1969); *In re Natta*, 48 FRD 319 (DC Del., 1969); *In re Natta*, only at 164 USPQ 71 (DC Del., 1969); *The Babcock & Wilcox Company v. Foster Wheeler Corporation*, only at 166 USPQ 390 (DC NJ, 1970); *The Babcock & Wilcox Company v. Foster Wheeler Corporation*, 54 FRD 474 (DC NJ, 1971); *The Babcock & Wilcox Company v. Foster Wheeler Corporation*, only at 173 USPQ 480 (DC NJ, 1972); *The Babcock & Wilcox Company v. Foster Wheeler Corporation*, only at 174 USPQ 147 (DC NJ, 1972).

Doyle *et al.* and Sheehan are involved in an interference—a "contested case(s) in the Patent Office." Doyle *et al.* have sought "production of documents" from Sheehan by serving him with a subpoena duces tecum issued by the District Court below.

The "plain meaning" of §24 is that the discovery rules of the Federal Rules of Civil Procedure apply to Patent Office interferences. This court has said many times that statutes are to be interpreted according to the plain meaning of the words used therein.

In *Banks v. Chicago Grain Trimmers Assn., Inc., et al.*, 390 U.S. 459 (1968), this court was called upon to interpret a portion of the Longshoremen's and Harbor Workers' Compensation Act which provided for review "because of a mistake in a determination of fact," by the Deputy Commission, "at any time prior to one year after the rejection of a claim." The court stated:

We find nothing in this legislative history to support the respondent's argument that a 'determination of fact' means only some determinations of fact and not others. The respondent points out that the recommendations of the Compensation Commission prior to the 1934 amendment referred to analogous state laws; but those recommendations dealt with the time period in which review was to be available, not with the grounds for review. The respondent has referred us to no decision, state or federal, holding that a statute permitting review of determinations of fact is limited to issues relating to disability. In the absence of persuasive reasons to the contrary, we attribute to the words of a statute their ordinary meaning, and we hold that the petitioner's second compensation action, filed a few

months after the rejection of her original claim, came within the scope of §22.

In *Malat v. Riddell*, 383 U.S. 596 (1966), this court was called upon to construe the word "primarily" in connection with a development of a property for rental purposes or sale, which would then determine whether the profits received capital gains treatment or were treated as ordinary income. In that case, the court stated:

As we have often said 'the words of statutes—including revenue acts—should be interpreted where possible in their ordinary, everyday senses.' *Crane v. Commissioner*, 331 U.S. 1, 6. And see *Hanover Bank v. Commissioner*, 369 U.S. 672, 687-688; *Commissioner v. Korell*, 339 U.S. 619, 627-628. Departure from a literal reading of statutory language may, on occasion, be indicated by relevant internal evidence of the statute itself and necessary in order to effect the legislative purpose. See, e.g., *Board of Governors v. Agnew*, 329 U.S. 441, 446-448.

It is believed clear from those decisions that there is absolutely no basis for the First Circuit to interpret 35 U.S.C. §24 to say that the phrase, "The Federal Rules of Civil Procedure" means only Rule 45 of the Federal Rules of Civil Procedure—but not all of Rule 45—*subpart (d)(1) being specifically excluded by the court's opinion*. Of course, the court's need to exclude that subpart is clear: Subpart (d)(1) of Rule 45 of the Federal Rules of Civil Procedure refers to Rules 26, 30 and 31, which would have the effect of making those Federal Rules of Civil Procedure relating to discovery effective, which is the clear intent of the statutory language employed by Congress but in direct conflict with the First Circuit's opinion.

In *Helvering v. Hammell*, 311 U.S. 540 (1941), this court spoke to the question of restrictive interpretation of statutory language:

True, courts in the interpretation of a statute have some scope for adopting a restricted rather than a literal or usual meaning of its words where acceptance of that meaning would lead to absurd results, *United States v. Katz*, 271 US 354, 362, 70 L ed 986, 990, 46 S Ct 513, or would thwart the obvious purpose of the statute, *Haggar Co. v. Helvering*, 308 US 389, 84 L ed 340, 60 S Ct 337. But courts are not free to reject that meaning where no such consequences follow and where, as here, it appears to be consonant with the purposes of the Act as declared by Congress and plainly disclosed by its structure. [Emphasis added.]

When the *Helvering* case is viewed in the light of this court's later statement in *Segal, et al. v. Rochell*, 382 U.S. 375 (1966), wherein it stated:

Nevertheless, we have been shown no legislative history on the point, and an uncertain guess as Congress' intent provides dubious ground for disregarding its plain language.

it is believed unequivocally clear that the First Circuit has adopted an interpretation of 35 U.S.C. §24 which is not only violative of the plain meaning rule of statutory interpretation, but clearly contrary to the intent of Congress.

35 U.S.C. §24 is a compilation of former §§54, 55 and 56 with the change that, instead of specific reference to §647 of Title 28 relating to the issuance of subpoenas

duces tecum, 35 U.S.C. §24 refers to the "provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and the production of documents and things." (See and contrast the language of 35 U.S.C. §54 and 35 U.S.C. §24, *supra*.) Had Congress intended to restrict the applicable Federal Rules of Civil Procedure to the subpoena power of Rule 45, then, as Judge Van Dusen pointed out in his dissent in *Frilette v. Kimberlin*, *supra*, Congress would have retained the wording of 35 U.S.C. §54 and merely substituted "Federal Rule of Civil Procedure 45" for "section 647 of Title 28." (See Appendix C for Judge Van Dusen's dissent.) There is no legislative history on 35 U.S.C. §24 and therefore one cannot, from reading the Congressional records, refer to specific statements of Congress. However, even a casual reference to 35 U.S.C. §24 will demonstrate a complete lack of justification for saying that the phrase, "Federal Rules of Civil Procedure," means, in fact, *Federal Rule* [singular] "45(a), (b), (c), (d)(2), (e) and (f)", but *not* (d)(1).

3. The Effect of the First Circuit's Decision Will Be to Suppress Relevant and Material Evidence so That When an Interference Reaches the Patent and Trade Mark Office's Board of Patent Interferences for Decision, the Case Will Be Decided on a Record Which Contains Less Than All of the Relevant and Material Evidence.

If the First Circuit's interpretation of 35 U.S.C. §24 is permitted to stand, discovery for use in Patent Office interferences will be precluded in that Circuit. Relevant and material evidence will be suppressed. Documents and materials properly "discoverable" which lead to relevant and material admissible evidence will never come to light in the first instance. The Patent Office will decide cases on incomplete evidence. One party who lacks full candor

may improperly obtain a seventeen-year patent monopoly through fraud or the simple suppression of relevant evidence on obviousness, test results or the intentional misnaming or omission of inventors.

Surely, in a matter as important as granting a patent to the proper party, all relevant and material evidence should be brought out through the discovery process so that the Patent Office will have a full and complete evidentiary record before it when it renders a decision.

CONCLUSION

Doyle *et al.*, request that a Writ of Certiorari issue to review the judgment and opinion of the First Circuit. There is a clear conflict in the Courts of Appeals between the First and Third Circuits, on the one hand, and the Second, Fifth, Sixth, Seventh and Tenth Circuits together with numerous district courts, on the other hand. The First Circuit recognized that its decision was creating a split within the circuits and suggested:

The Supreme Court may think it desirable to terminate the divergent interpretations that now exist.

In its most recent decision, the Second Circuit has maintained its previous position along with the Fifth, Sixth, Seventh and Tenth Circuits in recognizing the right of patent interference parties to discovery under 35 U.S.C. §24.

It is therefore clear that absent issuance of a Writ of Certiorari, parties involved in Patent Office interferences will be forced to forum shop. Those seeking discovery will attempt to secure such discovery from the

opposing party in favorable districts, such as the Second, Fifth, Sixth, Seventh and Tenth Circuits, or the various District Courts in Circuits other than the First and Third which have recognized the right of parties to take discovery. In turn, parties from whom discovery is sought will no doubt try to argue that they are only properly within the jurisdiction of the First and Third Circuits and that discovery is thus precluded.

35 U.S.C. §24 involves a fundamental right to discovery under the Federal Rules of Civil Procedure. Failure to permit discovery can result in awarding the right to a patent and the accompanying seventeen-year monopoly to the wrong party which would be clearly contrary to the intent of the United States patent statutes (Title 35 of the United States Code) and the Constitution of the United States, Article I, Section 8.

Respectfully submitted,

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APPENDICES

APPENDIX A**United States Court of Appeals
For the First Circuit**

No. 75-1218

JOHN C. SHEEHAN,
PLAINTIFF, APPELLEE,
v.
DOYLE, ET AL.,
DEFENDANTS, APPELLANTS.

APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS
[HON. WALTER J. SKINNER, U.S. District Judge]

Before COFFIN, Chief Judge,
MCENTEE and CAMPBELL, Circuit Judges.

Albert L. Jacobs, Jr., with whom *Jacobs & Jacobs, P.C.*, *Owen F. Clarke, Jr.*, *Sullivan & Worcester*, *Albert L. Jacobs*, *Mark H. Sparrow*, and *Bruce M. Collins* were on brief, for appellants.

Thomas E. Spath, with whom *N. Dale Sayre*, *McLean, Bousted & Sayre*, *Robert J. Horn, Jr.*, and *Kenway and Jenney* were on brief, for appellee.

January 30, 1976

Pre Curiam. In this appeal, Doyle questions the wisdom of our decision in *Sheehan v. Doyle*, 513 F.2d 895 (1st Cir. 1975). In that case, Sheehan had sought documentary discovery from Doyle, and the latter had defended on grounds that Doyle, a nonresident alien, was beyond the jurisdiction and venue of the district court. We sustained Doyle, but on the ground that 35 U.S.C. § 24 "does not confer jurisdiction upon the district court, acting on its own, to grant Rule 34 discovery directly, whether against a nonresident alien or a resident citizen." 513 F.2d at 898. In this, we relied heav-

ily on the *en banc* decision of the third circuit in *Frilette v. Kimberlin*, 508 F.2d 205 (1975). In the present proceeding, it is Doyle who seeks discovery; and, after being peremptorily turned down by the district court on the basis of our decision in *Sheehan v. Doyle*, he bring this appeal.

We first dispose of Doyle's argument that as the discovery he seeks is by a *subpoena duces tecum*, it is not precluded by our earlier decision. The thrust of that decision was that 35 U.S.C. § 24 provided for judicial subpoenas to be used in aid of contested Patent Office cases (including for purposes of broad-based Federal Rules discovery) but only to the extent permitted by the Commissioner of Patents. What we rejected, and this would apply as much in the present case as in the earlier one, was use of the federal district courts "as alternative forums of first resort rather than as forums acting strictly in aid of the primary proceeding." 513 F.2d at 899. Thus the district court correctly interpreted our decision as ruling out administratively unauthorized^{*} discovery of this nature.

Here, if discovery proceeds, it will be more of the free-wheeling discovery which the third circuit and this circuit have determined Congress did not mean to authorize. Indeed, the very nature of the discovery here sought points up our earlier objections. Doyle seeks to probe whether Sheehan was the actual inventor, and Sheehan argues that that issue is entirely irrelevant to a patent office interference. Since the discovery proceeding is totally separate from the interference, and since no one from the Patent Office is a party or has purported to outline the scope of

* From the Patent Office's granting of several continuances to permit court-sponsored discovery, Doyle argues tacit Patent Office approval of these proceedings. However, until 1975, all circuits considering the issue had ruled that independent discovery of this nature was in order, and the Patent Office had every reason to feel that it was obliged to go along willy nilly. Thus we draw no inferences from any Patent Office continuances.

discovery, the district judge would have to rule on this and similar contentions with little to guide him but the parties' conflicting ideas of what might or might not be deemed relevant by the Board of Patent Interferences. Plainly the issue of what is relevant to its own proceeding can best be determined, at least initially, by the administrative agency in question. For over 400 district judges scattered throughout the nation to attempt to rule on such questions in a vacuum scarcely seems sensible, and, as pointed out in *Frilette*, is a procedure without precedent elsewhere.

This brings us to whether or not we should abandon the construction of 35 U.S.C. § 24 that we adopted in *Sheehan v. Doyle*. We see no reason now to change our mind.* Plainly, as we were well aware last spring, § 24 admits of more than one reading. But for reasons stated both in *Frilette* and our own opinion, we can see little sense in the sort of proceeding that a contrary interpretation has generated. Were the legislative history and statute clear, we would have no recourse; but the legislative history is totally devoid of any indication that Congress had in mind such an anomalous and unusual result, and we are unwilling to settle for what we perceive to be a fundamentally unsound approach where an equally or more persuasive interpretation of the statute exists.

We regret the uncertainty which a circuit split creates. There are, however, possible remedies. The Supreme Court may think it desirable to terminate the divergent interpretations that now exist. Alternatively, other circuits may follow the third circuit in abandoning the earlier construction. And the Commissioner of Patents, exercising such powers as he now has, may find that he is able to contribute

* See note, *Discovery in Patent Interference Proceedings*, 89 Harv. L. Rev. 573 (1976), supporting our reading of the statute and view of the statutory history.

to clarification of the situation. Finally, of course, Congress may by legislative enactment make clear its wishes in this unsettled area.

Affirmed.

APPENDIX B

Decision by Mr. Justice Walter Jay Skinner

The Court of Appeals having
ruled on March 31, 1975,
the motion to quash the
subpoena is allowed, without hearing,
in accordance with the opinion of the
Court of Appeals.

5-31-75

W.J. Skinner, Jr.

APPENDIX C

No. 11, 287 F.2d 810, 818 (3d Cir. 1961); Hennesey v. Securities & Exchange Commission, 285 F.2d 511, 515 (3d Cir. 1961). "The provisions of the Federal Rules of Civil Procedure" does not plainly mean only one of these Rules, namely, Rule 45, as decided by the majority. In addition to the plain meaning of the present statutory language, an analysis of the previous language and amendments thereto contradicts the majority's position. The applicable statutory language, as contained in Title 35 U.S.C. prior to the July 1952 Act, and the substitute language in 35 U.S.C. § 24 are set out as follows:

35 U.S.C. § 54
prior to July 19, 1952

"The clerk of any court of the United States, for any district or Territory wherein testimony is to be taken for use in any contested case in the Patent Office, shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. *The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent Office.*"

The plain or ordinary meaning of words used in a statute is applied in its construction. See Banks v. Chicago Grain Trimmers Ass'n, 390 U.S. 459, 465 (1968); Malat v. Riddle, 383 U.S. 569, 571 (1966); Hughes v. Local

not the reason for rejection of that case. If Natta had correctly interpreted § 24, the side effects would be worthy of note, but not grounds for disavowal of jurisdiction.

¹S. 1321 and S. 2504 would give authority to the Patent Office to issue subpoenas and require the Commissioner of Patents to establish rules for discovery similar to those of the Federal Rules of Civil Procedure. S. 2930 requires issuances of subpoenas by the clerk of the District Court and provides that the Federal Rules of Civil Procedure as applicable to discovery shall apply.

²I do not disagree with the majority opinion's statement that the language of the majority in *In re Natta*, 388 F.2d 215, 156 USPQ 289 (3d Cir. 1968), gave an unjustifiably broad interpretation to the 1952 amendment to 35 U.S.C. § 24.

³The words "F.R. Civ. P. 45" had been substituted for "section 647 of Title 28" by the terms of 28 U.S.C. § 723b and c (Act of June 19, 1934, Ch. 651, 48 Stat. 1064, which was amended by Act of June 25, 1948, Ch. 646, 62 Stat. 961), which terms are now contained in 28 U.S.C. § 2072 as follows:

First paragraph of
35 U.S.C. § 24 after
July 19, 1952

"The clerk of any United States court for the district wherein testimony is to be taken for use in any contested case in the Patent Office, shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. *The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent Office.*"

The reference to Rule 45 was effectively contained in the statute prior to the 1952 Act. Not only did the amending language alter this reference, but it also referred for the first time to the "provisions of the *** Rules *** relating to *** the production of documents and things." These exact words were used in the title of Rule 34 as it existed in 1952. The title to this Rule, as amended in 1946,³ read as follows in 1952:

"Rule 34. Discovery and Production of Documents and Things for Inspection, Copying, or Photographing."

As opposed to this title, the titles and subtitles of Rule 45 read as follows:

"Rule 45.
"SUBPOENA
"(a) For Attendance of Witnesses; Form; Issuance.

"(b) For Production of Documentary Evidence.

"(c) Service.

"(d) Subpoena for Taking Depositions; Place of Examination.

"(e) Subpoena for a Hearing or Trial.

"(f) Contempt.
***"

According to the plain meaning of the words used in (a) 35 U.S.C. § 24, as amended in 1952, and (b) Rules 34 and 45, it seems clear that the words "The Federal Rules of Civil Procedure" referred at least to Rule 34 as well as Rule 45. Otherwise, Congress could have retained the wording of 35 U.S.C. § 54, merely substituting "Federal Rule of Civil Procedure 45" for "section 647 of Title 28."⁴

"All laws in conflict with such rules shall be of no further force or effect after such rules shall have taken effect." Title 28, section 647, was repealed when F.R. Civ. P. 45 became effective in April 1938. See U.S.C.A. Tables, I, Revised Titles, at 43.

⁴See page 13 of House Document 473, 80th Cong., 1st Sess.

⁵See note 2 above. Congress might have hesitated to cite in § 24 a single rule of procedure, since the rules are not statutes and thus not subject to the closest congressional control over content and wording. Nevertheless, no reason appears why Congress would have failed to specify the provisions of the Rules of Civil Procedure relating to subpoenas had the intent been to limit the reference to Rule 45. Also, the legislative history of the 1952 Act shows that Congress changed the language of 35 U.S.C. § 24 as it first appeared in a draft bill to provide that "the provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things," which is the language appearing in the 1952 Patent Act.

A. Frilette Case

In the Frilette case, during the preparations-for-testimony stage, prior to the commencement of the junior party Frilette's taking of testimony, Frilette filed a motion for discovery with the Board of Patent Interferences under Patent Office Rule 287(c), seeking certain information from Kimberlin. The Board of Patent Interferences denied the motion in a decision dated January 17, 1973, on the ground, *inter alia*, that the motion under 287(c) for additional discovery was premature "since the time for service of documents and lists by Kimberlin ***, the senior party, under Rule 287(a) has not closed and in view of the fact that it is therefore not known what documents and lists will be served ***."

Frilette also filed in the district court a motion to compel discovery under F.R. Civ. P. 37. In this motion, Frilette sought substantially the same discovery sought in the Patent Office, and requested an order compelling Kimberlin (1) to designate certain witnesses under F.R. Civ. P. 30(b)(6), (2) to answer certain interrogatories under F.R. Civ. P. 33, (3) to produce documents under F.R. Civ. P. 34, and (4) to admit certain facts under F.R. Civ. P. 36. A hearing on this motion was held before the district court, and, in an Opinion and Order dated May 15, 1973, the district court denied the motion. See *Frilette v. Kimberlin*, 358 F.Supp. 493, 178 USPQ 387 (D. Del. 1973).

Frilette appeals from this denial of his motion.

to contested cases in the Patent Office. H.R. 9133 was introduced in the 81st Congress on July 17, 1950, and this bill was reintroduced in revised form in the 82nd Congress as H.R. 3760, which became the Patent Act of July 19, 1952 (P.L. 593, 82nd Cong., 2d Sess., c. 950; 66 Stat. 792). H.R. 9133 contained this language in the last half of the last sentence of the first paragraph of 35 U.S.C. § 24:

"* * * and the provisions of the Federal Rules of Civil Procedure relating to the issuance of subpoenas duces tecum shall apply to contested cases in the Patent Office."

When this bill was reintroduced in revised form in the 82nd Congress as H.R. 3760, the last sentence of the first paragraph of proposed 35 U.S.C. § 24 had been changed to read:

"The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and the production of documents and things shall apply to contested cases in the Patent Office."

The result of the many suggestions from the Patent Bar and the public concerning H.R. 9133 and the reintroduction of this bill in revised form in the 82nd Congress as H.R. 3760 is contained in House Report No. 1923, May 12, 1952. This history reveals the substitution for the words "the issuance of subpoenas duces tecum" of the words "the attendance of witnesses and the production of documents and things," which is the language appearing in the 1952 Patent Act.

The district court, in denying Frilette's motion to compel discovery, stated that the law as previously enunciated should no longer prevail because of the recent occurrence of two events: (1) the 1970 amendments to the Federal Rules of Civil Procedure which eliminated the good cause requirement as a prerequisite to Rule 34 document requests, and (2) the introduction by the Patent Office in June 1971 of the discovery provisions of Rule 287.

With respect to the 1970 amendments, the district court stated:

"Since the good cause requirement was apparently a factor in the federal courts' willingness to interpret § 24 broadly, this Court is unable to conclude that § 24 would have received a similar construction absent this safeguard. In such circumstances, it would not be unreasonable to continue to impose a good cause requirement under 35 U.S.C. § 24."

358 F.Supp. at 495-96, 178 USPQ at 388-389. The district court went on to conclude that Frilette had not made a showing of good cause.

With respect to the recent introduction by the Patent Office of the discovery provisions of Rule 287, the district court stated that the absence of any discovery mechanism in the Patent Office prior to the promulgation of Rule 287 had been a significant factor in the federal courts' willingness to give 35 U.S.C. § 24 a broad reading and to assume jurisdiction over discovery matters in interference proceedings. The district court felt that the introduction of the Patent Office discovery rules "appear[s] to reflect the Patent Office's efforts to construct a discovery process which embodies the good cause requirement cited" in such cases as *In re Natta*, *supra*, and that Rule 287 might, therefore, require a redefinition of the federal courts' role in granting discovery in interference proceedings under 35 U.S.C. § 24.

Based upon the above two considerations, the district court announced the following limitation on its role in interference discovery cases arising under 35 U.S.C. § 24:

"While a federal court cannot abrogate its responsibility to assume jurisdiction under 35 U.S.C. § 24, it must not blind itself to the ancillary, supportive role, it is designed to fulfill in interference matters. Until the Patent Office has had a reasonable opportunity to implement its discovery procedures and has demonstrated the parameters within which they will be administered, the courts are in no position to evaluate the potential efficacy of the procedures and the possibility that the courts will be able to assume a secondary role in discovery. In light of these general considerations, the Court must scrutinize Frilette's particular discov-

ery requests in light of the issues before the Patent Office."

358 F.Supp. at 496, 178 USPQ at 389. Frilette's primary contention on appeal is that, in light of the elimination by Congress in 1970 of the good cause requirement as a prerequisite to the grant of discovery under F.R. Civ. P. 34, the district court erred in judicially imposing a good cause requirement upon a party seeking discovery in an interference proceeding.

Specifically, Frilette claims that the district court's resurrection of the good cause requirement, on the ground that 35 U.S.C. § 24 would have received a different construction by this court in *Natta* and other courts absent the good cause safeguard, has no basis in logic. First, Frilette notes that good cause is not, and never was, a requirement of any of the discovery rules except F.R. Civ. P. 34, and that courts have granted discovery in patent interferences under such other discovery rules without regard to good cause. See, e.g., Babcock & Wilcox Co. v. Foster Wheeler Corp., 54 F.R.D. 474, 172 USPQ 286 (D. N.J. 1971) (motion to compel discovery under F.R. Civ. P. 37). Secondly, Frilette contends that the reasons for the 1970 amendment of F.R. Civ. P. 34, eliminating the good cause requirement, apply with equal force whether the parties seeking discovery are parties to a Patent Office interference or litigants in a different type of civil proceeding.¹ Finally, Frilette contends that the application of a different standard to the scope of discovery under the Federal Rules when the interference is pending before the Patent Office would not only impair the Patent Office's quest for truth but also necessarily increase the number of suits in the district courts under 35 U.S.C. § 146 after decisions of the Board of Patent Interferences since, as the district court in the instant case noted, "on appeal to the district court from a decision by the Board of Patent Interferences, the movant may be entitled to broad discovery under the Federal Rules without any showing of good cause or other particular reason for the requested discovery." 358 F.Supp. at 498 n. 7, 178 USPQ 390. Thus, Frilette argues, losing parties in interference proceedings are more inclined to bring a civil action under 35 U.S.C.

¹ The Advisory Committee's Note concerning the 1970 changes in F.R. Civ. P. 34 stated:

"Good cause is eliminated because it has furnished an uncertain and erratic protection to the parties from whom production is sought and is now rendered unnecessary by virtue of the more specific provisions added to Rule 26(b) relating to materials assembled in preparation for trial and to experts retained or consulted by parties."

See Moore's Federal Practice, Vol. 4A, ¶ 34.01[8] 2d ed. (1972).

§ 146 if broader discovery is available in such civil action.

I agree with these contentions and accordingly would hold that the district court erred in judicially imposing a good cause requirement upon discovery in patent interferences under 35 U.S.C. § 24. In 1970, Congress saw fit to permit the removal of the good cause requirement from the Federal Rules of Civil Procedure to become effective, and I perceive no logical reason why courts should carve an exception to such legislative action with respect to patent interferences. The district court, in resolving Frilette's request for discovery in the instant case, should have considered the same factors that it would consider in resolving a discovery request in any other civil proceeding.

One further aspect of this case requires discussion. As stated above, the district court, in addition to requiring Frilette to show good cause, stated that the Patent Office's recent promulgation of Rule 287 rendered distinguishable the *Natta* case and other cases which provided for broad discovery in the federal courts under 35 U.S.C. § 24. Reasoning that the presence of Rule 287 might require a restructuring of the federal courts' role under 35 U.S.C. § 24 and enable federal courts to assume a more limited, secondary role in interference discovery matters, the district court proceeded to "scrutinize Frilette's particular discovery requests in light of the issues before the Patent Office." The district court then noted, in denying Frilette's motion, "that under Rule 287(a) and (c), Frilette's discovery directed to Kimberlin's case in chief is premature." 358 F.Supp. at 498, 178 USPQ at 390. The district court did not make clear, however, whether its denial of Frilette's motion was based solely upon Frilette's inability to show good cause or also upon the Patent Office's prior denial of Frilette's motion as premature under Rule 287(a) and (c). Because of this uncertainty, I would remand to the district court for reconsideration of Frilette's discovery motion and, if necessary, clarification of its reasons for denial of such motion, in light of my belief that the district court erred in requiring Frilette to show good cause.

Accordingly, I would not attempt to resolve definitively in this appeal the issue of what effect Patent Office Rule 287 has upon the availability of discovery under 35 U.S.C. § 24, particularly where the Board of Patent Interferences has denied a motion under Patent Office Rule 287 requesting the same discovery.² I have, however, substantial doubt as

² I recognize that in many cases it will be desirable for the parties to seek discovery first under Rule 287, but it is not necessary to make a definitive ruling on this point in this case. See *Frilette v. Kimberlin*, 358 F.Supp. 493-496, 178 USPQ at 387-389

to whether the presence of Rule 287 compels a narrowing of the federal court's broad role in interference discovery proceedings under 35 U.S.C. § 24. Several factors underlie this doubt. First, on its face, Rule 287 provides for only limited discovery in the Patent Office. Under Rule 287(a), discovery is available prior to the testimony period solely for the purpose of determining the matters upon which the opponent will rely, not those which might build an affirmative case for the discovering party.³ Therefore, Rule 287 does not provide for discovery as broad in scope as the discovery which may be provided by a district court under § 24. Secondly, Congress, presumably well aware of the conflict between the availability of broad discovery under 35 U.S.C. § 24 and the traditional order of proof procedure of interference proceedings,⁴ repeatedly refused to amend 35 U.S.C. § 24 to eliminate this conflict prior to the adoption of Rule 287 in June 1971.⁵

(D. Del. 1973). See also note 9, *infra*. Also, I believe that any discovery ruling by the Patent Office is a factor to be considered by the district court in ruling on a motion such as that presented to the district court in this case. Cf. *Laveson v. Trans World Airlines*, 471 F.2d 76 (3d Cir. 1972); *In re Natta*, 264 F.Supp. 734, 738, 153 USPQ 11, 14-15 (D. Del. 1967).

³ While Patent Office Rule 287(c) provides that the Board of Patent Interferences may grant further discovery privileges at any time during the interference proceeding and to the full extent allowed under the Federal Rules, this power is discretionary and is not subject to interlocutory review. Moreover, Rule 287 applies only to the parties, so that no discovery of witnesses not under the control of the parties is available.

⁴ The traditional procedure in the Patent Office is that the parties present evidence in the inverse order of their filing date. Allowing the senior party to present its affirmative case after the junior party presents its affirmative case is intended to preserve the senior party's presumption that he is the first inventor. The discovery mechanism of Rule 287 is apparently designed to preserve this traditional procedure of maintaining the order of presenting proof by the parties.

⁵ Congress has on several occasions refused to enact bills which proposed a change in the language of 35 U.S.C. § 24 to read as follows:

"(a) The clerk of any United States Court for the district wherein testimony is to be taken in accordance with regulations established by the Commissioner for use in any contested case in the Patent Office shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and the production of documents and things shall apply to contested cases in the Patent Office insofar as consistent with such regulations."

Finally, the language of 35 U.S.C. § 24 is mandatory, and it is questionable whether the Patent Office's promulgation of a narrow discovery rule can restrict the force and effect of such language. I believe that the district court should take the above factors into account in reconsidering Frilette's motion.

As a final matter, I reject the contention of appellee Kimberlin that the district court order denying Frilette's discovery motion was conditional rather than final, and that it was, therefore, not an appealable final order under 28 U.S.C. § 1291(a). See Babcock & Wilcox Co. v. Foster Wheeler Corp., 415 F.2d 777, 163 USPQ 140 (3d Cir. 1969). In my view, the district court order was intended to be a final disposition of Frilette's motion for discovery.

I would vacate the May 15, 1973, district court order and remand the case to the district court for proceedings consistent with the foregoing views.

B. Duffy Case

As stated in Judge Adams' opinion, I agree that the district court did not abuse its discretion in allowing Duffy to proceed with discovery relating to whether Barnes and Preziosi filed their patent application fraudulently.

Judge Adams concurs in the statutory analysis set forth in this opinion and in the application of that analysis to the Frilette case.

See S. 3892, 90th Cong. 2d Sess. § 24 (1968); S. 1246, 91st Cong. 1st Sess. § 24 (1969); S. 643, 92nd Cong., 1st Sess. § 24 (1971). These bills were introduced before the Patent Office adopted Rule 287. Other bills introduced before the adoption of Rule 287 proposed no change in the language of 35 U.S.C. § 24. See S. 1042, 90th Cong., 1st Sess. § 24 (1967); S. 2597, 90th Cong., 1st Sess. § 24 (1967); S. 2756, 91st Cong., 1st Sess. § 24 (1969); cf. also S. 2504 (Committee Print), 93rd Cong., 1st Sess., A Bill for the general reform and modernization of the Patent Laws, title 35 of the United States Code at Section 23(b)(1), p. 10, Section 135(c)(3), p. 45, and Section 145 at p. 51.

APPENDIX D

In *The Babcock & Wilcox Company v. Combustion Engineering, Inc.*, 314 F. Supp. 937 (D.C. Conn., 1968); aff'd 430 F.2d 1117 (C.A. 2, 1968), discovery by a junior party to a Patent Office interference under 35 U.S.C. § 24 was not limited to the preparation of rebuttal material but could be used for the preparation of his direct case. The court said that Congressional intent to allow both parties to apply for discovery at any time during the proceeding must only meet the requirements of good cause, relevance, reasonable designation of documents and privilege. Subsequent to that case, good cause was eliminated as a requirement of Rule 26 of the Federal Rules of Civil Procedure.

In *Gladrow v. Weisz*, 354 F.2d 464 (C.A. 5, 1965), the Fifth Circuit said that Rule 34 of the Federal Rules of Civil Procedure permits the court to require production of documents under the control of a party during cross-examination without a subpoena.

In *Ochsner et al. v. Mills*, 382 F.2d 618 (C.A. 6, 1967), in holding the District Court's order denying a motion to compel discovery was appealable, the Sixth Circuit noted that 35 U.S.C. § 141 and 35 U.S.C. § 146 review does not provide actual review of the District Court's ruling. Appeal to the CCPA, which is an alternative appeal from the Patent Office Board of Interferences, is limited to the record before the court. An appeal to a Federal District Court under 35 U.S.C. § 146 carries a presumption of administrative correctness which is not the case with an appeal to the CCPA. The Sixth Circuit thus found the order final and appealable, thereby affirming that discovery for

use in Patent Office interference was expressly provided by 35 U.S.C. §24 in conjunction with the Federal Rules of Civil Procedure.

In *Natta et al. v. Zletz et al.*, 379 F.2d 615 (CA 7, 1967), the Seventh Circuit stated that the Patent Office had no power to order production, much less did it have any power to review the question of appellants' rights to the documentary production denied appellants by the District Court. The ruling by the District Court below that it would not entertain Rule 34 discovery until the Patent Office set a specific time for testimony was reversed by the Seventh Circuit which went on to state that it was error for the District Court to so condition the exercise of its authorized ancillary jurisdiction (under 35 U.S.C. §24), a jurisdiction designed cooperatively to complement the Patent Office's jurisdiction as an aid in the quest for truth.

In *Natta et al. v. Zletz et al.*, 405 F.2d 99 (CA 7, 1968); cert. den'd 395 U.S. 909 (1969); the Seventh Circuit, in reversing the District Court's order as "too restrictive," held it "not in accord with the broad type of discovery and duty of full disclosure contemplated by the Patent Laws, including 35 U.S.C. §24." The maximum amount of evidence should be available to the Patent Office for its sifting of the interference issues, said the Seventh Circuit. Parties should have access to documents which are relevant or which may lead to relevant matters within the purview of Rules 26(b) and 34 of the Federal Rules of Civil Procedure.

In *Natta et al v. Zletz et al.*, 418 F.2d 633 (CA 7, 1969), the Seventh Circuit stated that the application of attorney-client privilege and work product applies to Rule 34 discovery for use in a Patent Office interference.

In *Natta et al. v. Hogan et al.*, 392 F.2d 688 (CA 10, 1968), the Tenth Circuit specifically held that Rule 34 proceedings are "within the sweep of the statute [35 U.S.C. §24]" and that it is *not* necessary to obtain a subpoena prior to a Rule 34 motion.

In addition to the Courts of Appeals which have spoken out above on the situation, a number of District Courts have similarly found 35 U.S.C. §24 to provide to parties in a Patent Office interference the same type of discovery available to federal court litigants. In *Hogan et al. v. Zletz et al.*, only at 151 USPQ 103 (N.D. Okla., 1966), the District Court held that Rule 34 of the Federal Rules of Civil Procedure applies to actions brought under 35 U.S.C. §24. The assignee of an interference party is a party under Rule 34 even though not named *per se* in the interference because it is a real party in interest and therefor one party may take discovery from the assignee of the other party. In *Hogan et al. v. Zletz v. Baxter et al. v. Natta et al.*, 43 F.R.D. 308 (N.D. Okla., 1967), the District Court granted in part a motion for discovery under FRCP 34. The decision dealt in considerable detail with the work-product rule and attorney-client privilege which were found to be applicable to discovery for use in a Patent Office interference.

In *Judd v. Engelhard et al.*, only at 159 USPQ 571 (E.D. Wis., 1968), the District Court permitted discovery pursuant to FRCP 34 where the Patent Office interference motion period had closed but the Patent Office had not rendered a decision on the motions. The particular decision was one of the early decisions among the District Courts which not only acknowledged an interference party's right to federal court discovery, but acknowledged his right to such discovery at an early stage of the interference.

In *Ziegler et al. v. Natta et al.*, only at 157 USPA 400 (S.D.N.Y., 1968), the District Court for the Southern District of New York ruled on a motion under 35 U.S.C. §24 as to whether the documents sought via discovery were privileged.

In *Brinker et al. v. Kray et al.*, only at 159 USPQ 348 (S.D.N.Y., 1968), the District Court for the Southern District of New York denied a motion to quash a subpoena, saying that the court would not pass on the weight, sufficiency or relevancy which the Patent Office should accord the documents sought by production. The court went on to say that a serious challenge to inventorship was made and the petitioner did not show prejudice as a result of allowing discovery.

In *Gorzengo et al. v. Maguire et al.*, 62 F.R.D. (D.C. S.D.N.Y., 1973), the District Court of the Southern District of New York, in permitting discovery, said that an interference party could not both rely on an application in the interference and then deny the opposing party access to the document.

In *Vogel et al. v. Jones et al.*, 346 F. Supp. 1005 (D.C. D.C., 1970), the District Court for the District of Columbia granted a motion for summary judgment by the defendant in an action brought under 35 U.S.C. §146 to review a decision of the Patent Office Board of Patent Interferences. In that case, the District Court refused to allow the plaintiff to pursue discovery in the 35 U.S.C. 146 review action where the Patent Office had refused to postpone the testimony period because the plaintiff had not shown that the discovery sought was necessary. The court acknowledged that the plaintiff had a right to file a 35 U.S.C. §24 pro-

ceeding initially during the time the interference was pending in the Patent Office and therefore the court would not permit the plaintiff to take discovery in an action under 35 U.S.C. §146 after the Board of Patent Interferences had rendered its decision. The court stated that it would not consider evidence on issues for which no testimony was offered.

In *Lomax et al. v. Kihara v. Von Der Ohe*, only at 175 U.S.P.Q. 538 (D.C. D.C., 1972), the District Court for the District of Columbia denied a motion to quash and authorized discovery under 35 U.S.C. §24 and Rule 26 of the Federal Rules of Civil Procedure *even though* the Patent Office had denied a motion by this same party under Patent Office Rule 37 C.F.R. 1.287 seeking discovery. The court stated that the arguments presented included the observation that the Patent Office is very strict and restricts discovery to admissible evidence rather than to relevant evidence as does the federal court. The court indicated that granting Rule 26 discovery would not "annihilate" Patent Office Rule 37 C.F.R. 1.287.